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OFFICE OF PETITIONS

In re Application of :
Tsuru et al. :
Application No. 10/561,595 : ON APPLICATION FOR
Filed: December 20, 2005 : PATENT TERM ADJUSTMENT
Attorney Docket No. 09812.0135 :
Title: Method and Apparatus For :
Determining A Quantization :
Scale Of Encoded Data :

This is a decision on the "NOTICE OF POSSIBLE PTO ERROR IN THE DETERMINATION OF A PATENT TERM ADJUSTMENT AND REQUEST FOR CLARIFICATION OF CALCULATION," filed September 11, 2009. This petition is properly treated under 37 CFR §1.705(b). Applicants submit that the correct patent term adjustment to be indicated on the patent is six hundred forty-one (641) days, not three hundred thirty-eight (338) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment.

The request for review of the patent term adjustment is
Dismissed.

On June 23, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated the patent term adjustment to date is 338 days. Applicants dispute the calculation and argue that the application is entitled to an overall adjustment of 641 days. Applicants, however, do not dispute any particular adjustment or reduction.

Nevertheless, the calculation of adjustment has been carefully reviewed, and no error has been found.

A 369 day adjustment was made for failure by the Office to mail at least one of the notifications under 35 U.S.C. 132 not later than fourteen months after the date on which the application

fulfilled the requirements under 35 U.S.C. 371, pursuant to § 1.702(a)(1). A non-final Office action was mailed on December 23, 2008, which is 14 months and 369 days after the application fulfilled the requirements of 35 U.S.C. 371 on October 20, 2006.

Further review of the record shows that a 31-day reduction was properly taken pursuant to 37 CFR 1.704(b). 37 CFR §1.704(b) provides:

an applicant shall be deemed to have failed to engage in reasonable efforts to conclude processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed.

The PTA was properly reduced by 31 days, the number of days in excess of three months that was taken to reply to the December 23, 2008 Office action.

As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office

In view thereof, it is concluded that the determination of patent term adjustment at the time of the mailing of the Notice of Allowance is three hundred thirty-eight (338) days.

The \$200.00 petition fee set forth in 37 CFR 1.18(e) has been assessed from deposit account no. 06-0916. No additional fees are required.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Charlema Grant, at (571) 272-3215.

/ALESIA M. BROWN/

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failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.